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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
VAUGHN JR, WILLIAM C	
ART UNIT	**PAPER NUMBER**
2143	22

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/494,956	Applicant(s) PHILYAW ET AL.	
	Examiner William C. Vaughn, Jr.	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 December 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *29,31,34 and 35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *29,31,34 and 35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

WCV

DETAILED ACTION

1. This Action is in regards to the Amendment and Response received on 08 December 2003.

Response to Arguments

2. Applicant's arguments and amendments filed on 08 December 2003 have been carefully considered but they are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new grounds of rejection as explained here below, necessitated by Applicant's substantial amendment (i.e., *in response to the step of causing...reproduced audio signature...audio signature*) to the claims which significantly affected the scope thereof.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 29, 31, 34 and 35** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al. (Hudetz), U.S. Patent No. 5,978,773 in view of Watanabe, U.S. Patent No. 6,163,803.

5. Regarding **claim 29**, Hudetz discloses the invention substantially as claimed. Hudetz discloses a method for conducting commerce between any of a plurality of first locations on a global communication network and a specific and determinable second location on the global communication network (internet, item 20) for allowing information to be transferred therebetween (Hudetz teaches a system that allows for a better way for consumers and others to

access resources on remote computers, particularly Web sites), [see Hudetz, Col. 3, lines 16-23 and Col. 9, lines 42-52], comprising (internet, item 20) the steps of: defining a unique signature for the specific and determinable second location on the global communication network(Hudetz teaches that a UPC symbol and that within a database there records that contain four identification fields that holds an URL suitable for locating resources on the internet), [see Hudetz, Col. 5, lines 55-67 and Col. 6, lines 8-27 and Col. 7, lines 5-57], which unique signature is permanently associates with the specific and determinable second location (Hudetz further teaches that an association of the Internet URL and narrative description is based on a criteria that identifies a web resource sponsored by a manufacturer of the selected product identified by the fields), [see Hudetz, Col. 7, lines 17-42]; storing a unique designation corresponding to the unique signature in a database at a remote location on the global communication network (Hudetz again teaches within the database are records which are accessible utilizing DBMS software and that within each record of the database there is an association between an UPC field and an Internet URL and a narrative description), [see Hudetz, Col. 7, lines 5-28 and Col. 9, lines 42-62]; associating with the unique designation in the database routing information over the global communication network to the specific and determinable second location from any of the plurality of first locations on the global communication network [see Hudetz, Col. 7, lines 5-28]; causing the unique audio signature to be reproduced at one or more of the plurality of first locations [see Hudetz, Col. 7, lines 64-67 and Col. 8, lines 1-9]; in response to the step of causing, transmitting the reproduced signature to the remote location and then, at the remote location, transmitting the associated routing information to the one of the first location that transmitted the reproduced audio signature (Hudetz teaches that information may be distributed

over more than one computer), [see Hudetz, Col. 7, lines 43-67 and Col. 8, lines 1-10]; and transferring information between the one or more of the first locations and the specific and determinable second location in response to the step of the advertiser causing the unique audio signature to be reproduced at one or more of the plurality of first locations and in accordance with the routing information stored in the database and associated with the reproduced unique audio signature [see Hudetz, Col. 7, lines 64-67 and Col. 8, lines 1-9]. However, Hudetz does not explicitly disclose an audio signature.

6. In the field of endeavor, Watanabe discloses (e.g., audio URL signal transmitting apparatus). Watanabe discloses a unique audio signature (Watanabe teaches an audio URL signal), [see Watanabe, Col. 7, lines 53-57].

7. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Watanabe's teachings of an audio URL signal transmitting apparatus with the teachings of Hudetz, for the purpose of making access to a web site easier, by utilizing an audio URL signal transmission [see Watanabe, Col. 19, lines 5-12]. Thus, Hudetz provides motivation to combine by stating the use of an RF data collection scanner to be used within the system [see Hudetz, Col. 12, lines 18-19]. By this rationale **claim 29** is rejected.

8. Regarding **claim 31**, Hudetz-Watanabe further discloses *wherein the unique audio signature has embedded therein encoded information* [see Watanabe, Col. 7, lines 32-67 and Col. 8, lines 1-46 and Col. 9, lines 35-46] *wherein the step of storing the unique audio designation in a database comprises storing the decoded version of the encoded information therein and the step of associating is operable to associate the decoded version of the unique*

encoded audio with routing information (Watanabe teaches decoder for extracting audio), [see Watanabe, Col. 6, lines 44-47]. By this rationale **claim 31** is rejected.

9. Regarding **claim 34**, Hudetz-Watanabe further discloses wherein the step of defining a unique audio signature comprises defining a unique audio signature that comprises an audio signal within the hearing range of a human [see Watanabe, Col. 19, lines 66-67 and Col. 19, lines 1-2]. By this rationale **claim 34** is rejected.

10. Regarding **claim 35**, Hudetz-Watanabe further discloses wherein the unique audio designation is compatible with the audio portion of a television broadcast [see Watanabe, Col. 9, lines 56-59]. By this rationale **claim 35** is rejected.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. **Claims 29, 31, 34 and 35** rejected under the judicially created doctrine of double patenting over claims 1, 2, 3, and 7-9 of U. S. Patent No. 6,622,165 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The context of the claims in the application is substantially the same (i.e., defining the unique audio signature) as well as being broader that the patented application.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent.

Response to Arguments

13. Applicant's arguments include the failure of previously applied art to expressly disclose providing unique allocation of an audio signature with a defined location (i.e., determinative location), (see Applicant's Response, Paper# 21, pages 5 and 6. It is evident from the detailed mappings found in the above rejection(s) that Hudetz-Watanabe in combination disclosed this functionality. Further, it is clear from the numerous teachings (previously and currently cited) that the provision providing unique allocation of an audio signature with a defined location (i.e., determinative location) was widely implemented in the networking art. Thus, Applicant's arguments drawn toward distinction of the claimed invention and the prior art teachings on this point are not considered persuasive. It is requested that Applicant provide clarification on the defining of the unique audio signature for the specific location. It is also suggested that Applicant look within their specification (i.e., page 14 and 15) regarding the details of different data fields and how they apply to the defining of a unique audio signature for a specific and determinable second location.

14. Again, it is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art. As it is Applicant's right to continue to claim as broadly as possible their invention. It is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique. As it is extremely well known in the networking art as already shown by Hudetz-Watanabe and other prior arts of records disclosed,

providing unique allocation of an audio signature with a defined location (i.e., determinative location) as well as other claimed features of Applicant's invention. Thus, it is clear that Applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claim invention.

15. Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response, and reiterates the need for the Applicant to more clearly and distinctly, define the claimed invention.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (703) 306-9129. The examiner can normally be reached on 8:00-6:00, 1st and 2nd Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WCV
Patent Examiner
Art Unit 2143
10 February 2004

MEHMET B. GECKIL
PRIMARY EXAMINER